

Appl. No. : 10/782,382  
Filed : February 19, 2004

### REMARKS

The following remarks are responsive to the July 6, 2006 Office Action. Claims 1-3 remain as originally filed. As a result, Claims 1-3 remain pending in the present application. Applicants respectfully request the Examiner to reconsider the application in view of the following comments.

#### Specification

Applicants have amended the Specification to update the status of all related applications noted in the first paragraph. Applicants respectfully request that this objection be withdrawn.

#### Information Disclosure Statement

Applicants filed an Information Disclosure Statement and accompanying Form PTO-1449 citing 219 references on September 13, 2004, a copy of which, stamped as received by the USPTO on September 16, 2004, is attached hereto for convenience. Applicants note that the Form PTO-1449 was not returned nor was inclusion of the same marked on the Office Action Cover Sheet. Accordingly, Applicants respectfully request the September 13, 2004 IDS be properly considered, and a copy of the submitted Form PTO-1449 including an indication of the consideration be returned in the next communication from the Patent Office.

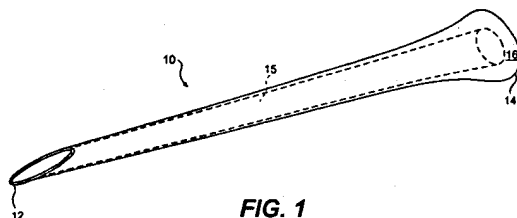
#### Double Patenting

The Examiner provisionally rejected Claims 1-3 under the doctrine of obviousness-type double patenting. The Examiner asserted that the Claims 1 and 2 were not patentably distinct from Claims 1, 3 and 5 of co-pending Application Ser. No. 11/121,584. The Examiner also asserted that Claim 3 was not patentably distinct from Claim 5 of co-pending Application Ser. No. 10/634,213 in view of Lynch, U.S. Patent No. 6,827,700. Applicants will file a terminal disclaimer when the provisional nonstatutory obviousness-type double patenting rejection is the only rejection remaining in the application, as provided at M.P.E.P. § 804, subsections I.B. The Applicants respectfully request that the Examiner provide the Applicants the opportunity to file a terminal disclaimer once allowable subject matter has been determined.

Response to Rejection of Claims 1 and 2 under 35 U.S.C. § 102(e)

In the July 6, 2006 Office Action, the Examiner rejected Claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,544,249, issued to Yu et al. ("Yu").

Applicants respectfully traverse this rejection. Applicants submit that Yu does not disclose each and every limitation recited in Claim 1. For example, Applicants submit that Yu fails to disclose, among other things, an implant comprising an inflow portion "wherein a long axis of the inflow portion is disposed at an angle to a long axis of the outflow portion," as recited in Claim 1. Yu discloses microfistula tubes comprising a hollow tube which has a single long axis extending through the inflow and outflow portions. (Col 5: Lns 51-52).



Conversely, Applicants disclose an implant wherein a long axis of the inflow portion is disposed at an angle with respect to a long axis of the outflow portion. For example, in one embodiment as shown in Fig. 5, the implant may be angulated such that the inlet section lies at an elevated plane, at an angle  $\theta$  with respect to the axis of the outlet portion, such that the long axis of the inlet portion is also disposed at an angle with respect to the outlet portion.

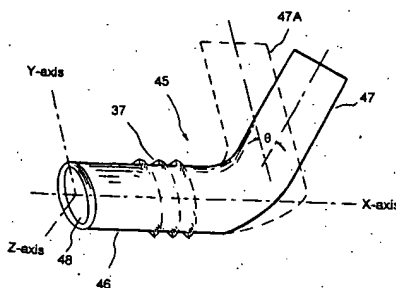


FIG. 5

Moreover, Applicants further submit that the applicator disclosed by Yu is not configured to be used with an implant having, *inter alia*, an inflow portion "wherein a long axis of the inflow portion is disposed at an angle to a long axis of the outflow portion." Yu discloses an

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applicator comprising an outer tube, an inner tube and a pusher wherein the implant is housed inside the outer tube and the inner tube is used to push the implant from the outer tube to its final position. (Col. 6: Lns 37-47). As depicted in Yu, the outer tube comprises a straight trocar for penetrating the cornea, thus, the Yu applicator can only be used to insert implants having a tubular shape.

Therefore, Applicants submit that Claim 1 is patentably distinguished over Yu. Claim 2 depends directly from Claim 1 and is therefore patentable over the cited art for at least the same reasons as Claim 1. Applicants respectfully request the Examiner to withdraw the rejection of Claims 1 and 2 and pass these claims to allowance.

Response to Rejection of Claim 3 under 35 U.S.C. § 103(a)

In the July 6, 2006 Office Action, the Examiner rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Yu in view of U.S. Patent No. 6,827,700 issued to Lynch et al. (Lynch). Applicants respectfully traverse this rejection.

Applicants submit that there is no motivation or suggestion in either Yu or Lynch to combine their disclosures. Indeed, it is not clear that the Lynch implant can be used with the Yu applicator, as suggested by Examiner's asserted combination. The Examiner states that it would have been obvious to modify the microfistula tube of Yu to be substantially shaped as taught by Lynch. However, the applicator disclosed by Yu is not configured to be used with an implant having a shape as taught by Lynch. Yu discloses an applicator comprising an outer tube, an inner tube and a pusher wherein the implant is housed inside the outer tube and the inner tube is used to push the implant from the outer tube to its final position. (Col. 6: Lns 37-47). As depicted in Yu, the outer tube comprises a straight trocar for penetrating the cornea and for injecting the implant into position within the eye after the applicator is advanced through the cornea. The Lynch device cannot be applied with a Yu applicator because the Lynch device requires an external approach through the unroofing of Schlemm's canal and the manual positioning of the arms of the device within the exposed Schlemm's canal. For example, Lynch discloses that "the surgical procedure necessary to insert the device requires an approach through a conjunctival flap," and the arms of the distal portion of the Lynch device "is grasped and threaded into Schlemm's canal." (Col 11: Lns 61-63, Col. 12: Ln 9). The Yu applicator cannot thread an implant in a direction other than along the axis of the straight trocar. Thus, the Yu

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applicator can only be used to insert implants having a straight tubular shape and cannot be used with implants shaped as described by Lynch. Furthermore, Lynch teaches away from using a straight applicator as described in Yu. Thus, there is no motivation to combine Yu and Lynch as suggested by Examiner.

Therefore, Applicants submit that Claim 3 is patentably distinguished over the combination of Yu and Lynch. Applicants respectfully request the Examiner to withdraw the rejection of Claim 3 and pass this claim to allowance.

### **CONCLUSION**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. Applicants have made a good faith effort to respond to the outstanding Office Action. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is cordially invited to contact Applicants' attorney, at the telephone number below, to resolve any such issues promptly.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Additionally, Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Furthermore, Applicants have distinguished Yu based on structural differences between the Yu disclosure and the claimed subject matter; however Applicants reserve the right to antedate the Yu reference in the future, in related cases or for claims relating to the same or similar subject matter.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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